been indicated as allowable. At this time Applicants wish to pursue all pending claims. No claims have been amended.

II. Rejection under 35 U.S.C. § 103

Claims 1-15, 30, 38-40, 53-74, 89, 97-100, 110-124, 139, 147-150, 160-171, 186, 194-197, and 207-216 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Harry's Cosmeticology at pp. 470-483, U.S. Patent No. 6,235,298 ("Naser et al."), and U.S. Patent No. 5,688,930 ("Bertho et al."). *Office Action* at pp. 2-5. Applicants respectfully traverse this rejection.

The Examiner continues to maintain the above rejection by stating that Harry's Cosmeticology "teaches film formers and additives claimed in the instant application ... [and shows] that these polymers are used in the art for shaping hair." *Id.* at p. 4. The Examiner supports the combination by stating that "[o]ne of ordinary skill in the art would be motivated to use the hair fixative of '298 [Naser] as all references are in the same field of endeavor." *Id.*

Applicants respectfully disagree. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See* M.P.E.P. § 2143. Moreover, evidence of a suggestion or motivation to modify or combine must be "clear and particular." *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

As the Examiner admits, none of the references alone teach the composition as claimed. Applicants respectfully submit that the Examiner is relying on hindsight to

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combine the cited references to obtain the claimed composition and has not set forth the requisite clear and particular evidence for the motivation to combine.

First, Harry's Cosmeticology and Naser are directed to different types of products. The cited pages in Harry's Cosmeticology describe hair sprays. The Examiner relies on Naser for disclosing "[p]olyquaternium claimed in the instant application" and for teaching polysaccharides. *Office Action* at p. 3. Naser, however, is directed to a "liquid surfactant composition, e.g., liquid shower gels or liquid shampoos." *Naser* at col. 1, lines 5-6. One of ordinary skill in the art would readily appreciate that hair sprays and liquid shower gels or shampoos are designed to achieve different objectives. Thus, the mere fact that the compositions of Harry's Cosmeticology and Naser are "in the same field of endeavor" is insufficient to support the combination of references.

Further, the Examiner has provided no motivation to combine Bertho with these references. The Examiner relies on Bertho for disclosing the at least one claimed compound and the "beneficial" aspects, as alleged by the Examiner, of "emulsifying, foaming and wetting and dispersant properties." *Id.* at p. 4. However, one of ordinary skill in the art would appreciate that such "emulsifying, foaming and wetting and dispersant properties" are not useful for hairsprays, according to Harry's Cosmeticology. In contrast, Harry's Cosmeticology states that the objective of hairsprays "is to deposit onto the dry hair an invisible film to protect it against all external agents ..." and further sets forth at least seven "stringent" requirements for a hair spray. *See* p. 475. There is no mention of the benefits of "emulsifying, foaming and wetting and dispersant properties."

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When a claimed invention combines two known elements, a patentability determination rests on "whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *In re Beattie*, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992) (internal citations omitted). Applicants respectfully submit that the benefits taught by Bertho do not apply to the hairsprays of Harry's Cosmeticology. Accordingly, the desirability to combine these references is not found in the cited art and the Examiner has merely relied on hindsight.

Finally, in response to the Applicants previous arguments, the Examiner states that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." Office Action at p. 5.

Applicants respectfully submit that the cited law of *In re Keller* does not apply to the facts here. The appellants in *Keller* and *Merck* argued that an individual reference did not suggest, or taught away from the claimed invention, when a combination of references was used in the rejection. This is not the case here. Applicants instead are discussing each individual case to show that there is no suggestion to combine the references, not to show that the claims are patentable over each individual reference. *Keller* and *Merck* differ from the present case and do not support the present rejection.

Because the references fail to provide specific guidance to arrive at this combination, a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of the rejection.

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III. Conclusion

Applicants respectfully request the reconsideration and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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